

Application Serial No: 09/851,376
Attorney Docket No.: ACT-131

REMARKS

Reexamination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.112, and light of the remarks that follow are respectfully requested.

Claims 1-26 are pending in the application, claims 21-26 having been newly presented. Claims 21-23 point out that the at least one fiber is a fiber stub and claims 24-26 point out that the at least one groove comprises a V-groove, support for which can be found at least at page 1, section [0015] of the application. The preamble of claim 20 has been corrected to place that claim in independent form.

At the outset, applicant notes with appreciation the allowability of claim 10 and the indication of allowable subject matter with respect to claims 4, 6, 7, 14, 16, 17 and 20.

Turning now to the Official Action, claims 1-3, 5, 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beraneck et al* (U.S. Patent No. 5,896,481). In addition, claims 11-13, 15, 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Beraneck et al* in view of *Yoneda et al* (U.S. Patent No. 5,717,803). These rejections are respectfully traversed for at least the following reasons.

The present invention relates to fiber optic devices and to methods of making fiber optic devices. Claim 1, for example, sets forth a fiber optic device. The fiber optic device comprises a substrate comprising at least one groove comprising a first surface; a fiber stop comprising a second surface; a bonding material; and at least one fiber comprising a third surface in the at least one groove. At least one of the first surface, the second surface, and the third surface has a wettability that increases in the direction of the fiber stop. Independent claim 11 sets forth a method for longitudinally locating an optical fiber comprising a stub end in a groove.

As described in the "Background" section of the application, placing an optical fiber in a groove is a simple matter, but locating the optical fiber longitudinally can be difficult. The fiber optic devices and methods of the invention provide a simple and elegant solution to this problem. This solution and each of the features of the present claims are not disclosed or suggested by the applied documents.

Application Serial No: 09/851,376
Attorney Docket No.: ACT-131

Beranek et al relates to the alignment of an optical fiber in a fiber-optic transmitter/receiver subassembly (col. 1, lines 14-16). FIG. 3 of *Beranek et al* discloses a micro-optical bench 200 that includes a solder groove 210 comprising a metallized, truncated V-shaped groove, sized to receive a metallized optical fiber to solder the fiber to the optical bench. At one end of the solder groove is a narrower cladding groove 212 sized to receive the optical fiber, and a narrower core groove 214.

Beranek et al does not disclose or suggest each feature of the present invention. For example, *Beranek et al* does not disclose or fairly suggest at least one of a first surface, a second surface, and a third surface having a wettability that increases in the direction of a fiber stop, as set forth in independent claims 1 and 11. The Examiner apparently believes that *Beranek et al* inherently discloses such a feature. Applicants respectfully disagree.

To support a rejection based on inherency, the Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. See *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (BPAI 1990). The inherency must flow as a necessary result from the prior art, not merely as a possible result. See *In re Oelrich*, 212 USPQ 323, 326 (C.C.P.A. 1981). Given the absence in *Beranek et al* of any express mention of the presently claimed wettability feature and the lack of technical grounds in the Official Action as to why such feature would necessarily result from the *Beranek et al* device, the Examiner has not met his burden in establishing inherency. Accordingly, the rejection based on *Beranek et al* alone is improper and should be withdrawn.

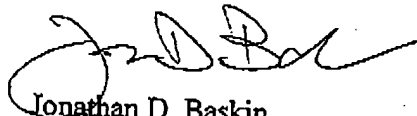
Moreover, *Yoneda et al* cannot cure the above-described deficiencies in the primary reference. For at least the foregoing reasons, withdrawal of these rejections is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

Application Serial No: 09/851,376
Attorney Docket No.: ACT-131

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at his earliest convenience.

Respectfully submitted,



Jonathan D. Baskin
Attorney for Applicant
Registration No. 39,499
Telephone No.: (508) 787-4766
Facsimile No.: (508) 787-4730

c/o EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, Massachusetts 02209
Date: August 29, 2003

RECEIVED
CENTRAL FAX CENTER

SEP 02 2003

OFFICIAL